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**DIRECTOR OFFICE
TECHNOLOGY CENTER 2100**

In re Application of: Franz Wakefield)
Application No.: 09/877,729)
Filed: June 8, 2001)
For: METHOD AND SYSTEM FOR)
CREATING, USING AND)
MODIFYING MULTIFUNCTIONAL)
WEBSITE HOT SPOTS)

**DECISION ON PETITION
UNDER 37 C.F.R. § 1.181 TO
WITHDRAW HOLDING OF
ABANDONMENT, TO
REFUND FEES, AND FOR
NOTICE OF ALLOWANCE**

This is a decision on the petition filed May 14, 2005 under 37 CFR § 1.181 to rescind an abandonment and grant additional relief. The petition is being treated as a request to withdraw the holding of abandonment¹ in the above captioned case.

The petition is **DENIED**.

RECENT CASE HISTORY

January 30, 2004 - Rejection mailed. Claims 1, 2, 5, 6, 8, 11-15, 19 and 20 are rejected under 35 U.S.C. §102(e) as anticipated by Horowitz et al.; Claims 3, 4, 7, 9, 10, and 16-18 are rejected under 35 U.S.C. §103(a) over Horowitz in view of various other references.

April 14, 2004 - Applicant dismisses attorney and takes over prosecution of the application *pro-se*.

April 14, 2004 - Interview Summary. Applicant and Examiner discuss using 37 C.F.R. §1.131 practice to antedate the Horowitz reference. (Mailed May 4, 2004)

April 26, 2004 - Applicant files response to Office Action of January 30, 2004. Response includes affidavit of Matthew B. Hinze.

¹ A petition under to revive 1.137(b) accompanied by an RCE and the appropriate fees was filed on May 10, 2005. Because withdrawal of the holding of abandonment would make the petition to revive unnecessary this petition (filed May 14) will be treated first.

- May 10, 2004 - Applicant files further response to Office Action of January 30, 2004. Response includes affidavit of inventor Franz A. Wakefield and Applicants record of the April 19, 2004 Interview.
- June 16, 2004 - Notice of Non-Compliant Amendment Mailed (with respect to the May 10, 2004 amendment)
- June 21, 2004 - Applicant submits a compliant response.
- October 1, 2004 - Examiner issues a Final rejection. The Office action maintains the art rejections and responds in detail as to the deficiencies in Applicant's attempted showing of priority.
- October 21, 2004 - Interview Summary detailing a 2 hour conversation between Applicant and Examiner regarding the deficiencies in the affidavit
- November 10, 2004 - Applicant Petitions for suspension of time periods and patent fees.
- December 13, 2004 - Petition is Dismissed
- January 7, 2005 - Response to Final Rejection filed. This response includes an Affidavit under 37 C.F.R. §1.131 of approximately 310 pages including exhibits and attachments.
- February 24, 2005 - Affidavit of Mr. Stephen A. Benedict filed.
- March 21, 2005 - Advisory action mailed informing Applicant that in accordance with 37 C.F.R. §1.116(e) the affidavit would not be entered at this time.
- April 25, 2005 - Interview with SPE explaining why Advisory action was issued. (Mailed May 2, 2005)
- May 2, 2005 - Interview Summary mailed memorializing April 26, 2005 interview with SPRE Brian Johnson and Conversations with SPRE Pinchus Laufer regarding details of Affidavit practice, Office practice and procedure, and the relationship between the Constitution, Statute, regulations, and administrative procedure.
- May 3, 2005 - Notice of Abandonment mailed.
- May 10, 2005 - Petition under 1.137 filed.

May 14, 2005 - The instant petition for review is filed.

BASIS OF OPINION

The relevant portions of the Statutes and Rules are reproduced below. Emphasis is added to draw attention to the critical phrases.

35 U.S.C. 133 Time for prosecuting application

Upon failure of the applicant to prosecute the application *within six months* after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

35 U.S.C. 134 Time period for reply to an Office action

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

37 CFR § 1.135 Abandonment for failure to respond within time period.

(a) If an applicant of a patent application fails to respond within the time period provided under § 1.134 and § 1.136, the application will become abandoned *unless an Office action indicates otherwise*.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper action as the condition of the case may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, *will not operate to save the application from abandonment*.

37 CFR § 1.113 Final rejection or action.

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for *ex parte* reexaminations filed under §1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§41.31 of this title), or to amendment as specified in §1.114 or §1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§1.181). *Reply to a final rejection or action must comply with §1.114 or paragraph (c) of this section*. For final actions in an *inter partes* reexamination filed under §1.913, see §1.953.

(c) Reply to a final rejection or action ***must include cancellation of, or appeal from the rejection of, each rejected claim.*** If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR § 1.116 Amendments after final action or appeal.

(a) An amendment after final action must comply with §1.114 or this section.

(c) ***The admission of, or refusal to admit,*** any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings ***will not operate to relieve the application*** or reexamination proceeding from its condition as subject to appeal or to save the application ***from abandonment under §1.135,*** or the reexamination prosecution from termination under §1.550(d) or §1.957(b) or limitation of further prosecution under §1.957(c).

(e) An affidavit or other evidence submitted after a final rejection or other final action (§1.113) in an application or in an *ex parte* reexamination filed under §1.510, or an action closing prosecution (§1.949) in an *inter partes* reexamination filed under §1.913 but before or on the same date of filing an appeal (§41.31 or §41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

37 CFR § 1.181 Petition to the Commissioner.

(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. ***The mere filing of a petition will not*** stay the period for reply to an Examiner's action which may be running against an application, nor ***act as a stay of other proceedings.***

37 CFR § 1.26 Refunds.

(a) ***The Commissioner may refund any fee paid by mistake or in excess of that required.*** A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent or trademark filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested, and will not notify the payor of such amounts. If a party paying a fee or requesting a refund does not provide the banking information necessary for making refunds by electronic funds transfer (31 U.S.C. 3332 and 31 CFR part 208), or instruct the Office that refunds are to be credited to a deposit account, the Commissioner may require such information, or use the banking information on the payment instrument to make a refund. Any refund of a fee paid by credit card will be by a credit to the credit card account to which the fee was charged.

MPEP 706.07 (f) Time to Reply to Final rejection

(O) If prosecution is to be reopened after a final Office action has been replied to, the finality of the previous Office action ***should be withdrawn to avoid the issue of abandonment*** and the payment of extension fees. For example, if a new reference comes to the attention of the

examiner which renders unpatentable a claim indicated to be allowable, the Office action should begin with a statement to the effect: The finality of the Office action mailed is hereby withdrawn in view of the new ground of rejection set forth below. Form Paragraph 7.42 could be used in addition to this statement.

MPEP 1206 Time for Filing Appeal Brief

37 CFR 1.192(a) provides 2 months from the date of the Notice of Appeal for the appellant to file an appeal brief... The usual period of time in which appellant must file his or her brief is 2 months from the date of appeal. The Office date of receipt of the Notice of Appeal (and not the date indicated on any certificate of Mailing under 37 CFR 1.8) is the date from which this 2 month time period is measured. See MPEP § 512... In the event that the appellant finds that he or she is unable to file a brief within the time period allotted by the rules, he or she may file a petition, with fee, to the examining group, requesting additional time under 37 CFR 1.136(a). *Additional time in excess of 5 months will not be granted* unless extraordinary circumstances are involved under 37 CFR 1.136(b).

MPEP 715.09 Seasonable Presentation

Affidavits or declarations under 37 CFR 1.131 must be timely presented in order to be admitted. Affidavits and declarations submitted under 37 CFR 1.131 and other evidence traversing rejections are considered timely if submitted:

- (A) prior to a final rejection;
- (B) before appeal in an application not having a final rejection; or
- (C) after final rejection and submitted
 - (1) with a first reply after final rejection for the purpose of overcoming a new ground of rejection or requirement made in the final rejection, or
 - (2) with a satisfactory showing under 37 CFR 1.116(b) or 37 CFR 1.195, or
 - (3) under 37 CFR 1.129(a).

All admitted affidavits and declarations are acknowledged and commented upon by the examiner in his or her next succeeding action.

RELIEF REQUESTED

Petitioner requests² that

- (1) the holding of abandonment be rescinded;
- (2) the fees for the Petition to revive and the accompanying RCE be refunded;
- (3) Entry of the January 7, 2005 Affidavit; and
- (4) Issuance of a Notice of allowance.

² The order and wording of the request is modified.

DECISION

(1) Request to rescind the abandonment

In support of the petition, Petitioner provides a "Statement of Uncontroverted Facts". This statement concedes that a proper Final rejection was mailed October 6, 2004. Applicant filed an response to the final rejection including an Affidavit on January 7, 2005.

However, the timely filing of a Response to the Final Rejection is not relevant to the abandonment because 37 CFR §§ 1.113, 1.116, 1.135 and 1.181, and the portion of MPEP 706.07(f) reproduced above make it clear that without a specific withdrawal of the Final Rejection the application will go abandoned without timely action on the part of Petitioner. In fact, Applicant was advised of the non-entry of the affidavit and that the application was not in condition for allowance by the Office mailing of March 21, 2005.

Based on the statutes, rules, and sections of the MPEP reproduced above, the period for the petitioner to file either a Notice of Appeal or an RCE (under 37 C.F.R. §1.114) expired on April 6, 2005 (i.e., six months from the date the Final Office action was mailed). Applicant makes no representation that a Notice of Appeal or an RCE was filed which would have prevented abandonment at the expiration of the six month period; therefore, the application is ***abandoned in fact***. Under these circumstances, petition under 1.181(a) is not appropriate.

MPEP 711.03(c) explains:

A petition to revive an abandoned application (discussed below) should not be confused with a petition from an examiner's holding of abandonment. Where an applicant contends that the application is not in fact abandoned (e.g., there is disagreement as to the sufficiency of the reply, or as to controlling dates), a petition under 37 CFR 1.181(a) requesting withdrawal of the holding of abandonment is the appropriate course of action, and such petition does not require a fee.

Where there is no dispute as to whether an application is abandoned (e.g., the applicant's contentions merely involve the cause of abandonment), a petition under 37 CFR 1.137 (accompanied by the appropriate petition fee) is necessary to revive the abandoned application.

The request to rescind the abandonment is **DENIED**.

(2) Request to refund the fees for the petition under 37 C.F.R. §1.137 and for the RCE

Because the abandonment is held to be proper and is not withdrawn, the petition for revival and the RCE are necessary to reinstate the application from abandoned to pending status. Therefore, the fee paid was not a mistake (a fee paid when no fee is required) in accordance with 37 C.F.R. 1.26(a). The

fee of \$750.00 paid by Applicant for a petition under 37 C.F.R. 1.137(b) and the fee of \$395.00 for the RCE was the proper small entity fee at the time the fee was paid. Therefore, the fee paid was not in excess of the amount of fee that was required. See also MPEP §607.02. Since the fee paid was not a mistake or in excess of the required amount, the request for a refund does not fit under the categories of reasons for the Office to grant a refund as set forth in 37 C.F.R. 1.26(a) and the fee should not be refunded in accordance with the provisions of 37 C.F.R. 1.26(a).

The request to refund the fees is **DENIED**.

(3) Request to have the January 7, 2005 affidavit and accompanying evidence entered

On January 7, 2005, Applicant filed an Affidavit in response to the Final Office action of October 6, 2004. The Examiner, citing 37 C.F.R. §1.116(e) refused entry to the new evidence. The undersigned notes that the affidavit will be entered as part of the filing of the RCE. Presumably, Applicant is requesting that the evidence be entered without Applicant filing an RCE.

Both MPEP 715.09 and 37 C.F.R. §1.116(e) support the Examiner's refusal to enter the affidavit in this instance. Applicant was aware of the Horowitz reference as of the issuance of the first office action; the affidavit was not in response to a new ground of rejection in the final; and there is no good and sufficient reason why this evidence was not presented earlier. Therefore, the Examiner properly refused entry.

Applicant is reminded that entry of amendments or evidence after a final rejection is not a matter of right. Generally, where the filing requires more than cursory review by the Examiner it will not be entered after a final rejection.

Insofar, as applicant challenges the Examiner's action in not entering the affidavit prior to the filing of an RCE, the Examiner's action is upheld.

The request to have the Affidavit entered without an RCE is **DENIED**.

Applicant is reminded that the Affidavit will be entered upon a granting of a petition to revive under 37 CFR §1.137.

(4) Issuance of a Notice of Allowance

Applicant requests that a Notice of allowance be issued in the application. The undersigned notes that a Notice of allowance can only be issued after a determination is made that all claims remaining in the application are patentable. At this stage of the prosecution, all claims are under rejection.

Furthermore, as a procedural matter, petitions on appealable matters ordinarily are not entertained. (See MPEP §1002). As stated in MPEP § 1201:

The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Commissioner of Patents and Trademarks should be carefully observed. The Board will not ordinarily hear a question which it believes should be decided by the Commissioner, and the Commissioner will not ordinarily entertain a petition where the question presented is an appealable matter.

Issuance of a Notice of Allowance would require a determination as to the validity of the rejections of record. Review of rejections are appealable matters within the purview of the BPAI.

Accordingly, the request for a Notice of Allowance is **DENIED**.

CONCLUSION

The requests for relief are **DENIED**.

The application is being forwarded to the Office of Petitions for treatment of the Petition under 37 CFR §1.137(b) filed on May 10, 2005.



Paul Sewell, Director (Acting)
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